

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks made herewith, which place the application into condition for allowance.

Status of the Claims and Formal Matters

Claims 1-8 are pending in the application. Claims 1, 3, 4, and 8 are currently amended. Please cancel claim 2 without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents. Applicants reserve the right to file divisional applications to pursue the full scope of the claims.

No new matter has been added by these amendments. Support is found throughout the specification and from the pending claims. Specific reference is made to page 7, line 14 of the specification regarding the removal of chaotropic agents and reactivating thiols, the recitation of which has been provided in the amendment to claim 1 herewith. Specific reference is also made to page 11, paragraph 1 of the specification regarding determination of the content of solubilized PHGPx, also provided in the amendment to claim 1.

Examiner Gitomer is thanked for entry of the preliminary amendment on August 31, 2001, and for granting March 9, 1999 as the priority date of the instant application.

The title of the present invention was objected to as allegedly lacking an apt description. The Office Action required a new title that is clearly indicative of the invention to which the claims are directed. Applicants have amended the title to now read, "Method to detect fertilization potential of sperm".

The instant specification was objected to because no figures 5 and 6 were found. Applicants respectfully submit copies of Figures 5 and 6 and note that the PCT application from which the instant application derives contains all of the figures. Additionally, a return-receipt postcard that was date-stamped as received by the PTO containing all of the necessary figures is also submitted. The date-stamped postcard provides evidence that all four drawing sheets were actually received by the PTO.

The instant specification was also objected to as allegedly lacking standard headings, such as, for example, "Brief Description of the Figures". The amendments to the specification made herewith now provide the necessary headings.

The instant specification was further objected to for allegedly failing to provide generic terminology with the trademarked reagent. Specifically, the Office Action objected to the term “IPGphor”. The specification has now been amended to generically describe IPGphor as a 2-D gel electrophoresis system. Consequently, reconsideration and withdrawal of the objections to this application are respectfully requested.

Rejection under 35 U.S.C. §101

Claim 8 was rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Specifically, the Office Action has objected to the recitation of “use of a method”. This rejection is respectfully traversed in view of the amendments to Claim 8 made herewith. Therefore, reconsideration and withdrawal of the §101 rejection is respectfully requested.

Rejection under 35 U.S.C. §112, 1st Paragraph

Claims 1, 4-7 were rejected under 35 U.S.C. §112, 1st paragraph, as allegedly lacking enablement. The Office Action contends that the limitations of claim 2 are critical or essential to the practice of the invention, which includes removal of chaotropic and reducing agents prior to determining PHGPx activity. Claim 1 has now been amended to recite this removal step. Therefore, reconsideration and withdrawal of the §112, 1st paragraph rejection is requested.

Rejection under 35 U.S.C. §112, 2nd Paragraph

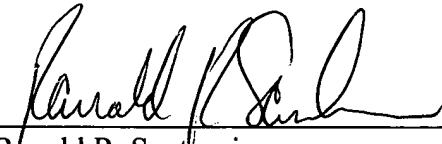
Claims 1-7 were rejected under 35 U.S.C. §112, 2nd paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1(b) specifically recited the term “using high concentrations”, which was objected to by the Office Action for failing to recite concentrations and further, the “use” of concentrations was not understood. Although Applicants respectfully disagree, Claim 1 has now been amended to render the rejection moot. Suitable concentrations of reactivating reagents are disclosed in the instant specification on page 3, lines 4-9, and also in claims 5 and 6. Reconsideration and withdrawal of the §112, 2nd paragraph rejection is therefore respectfully requested.

CONCLUSIONS

In view of the foregoing, favorable consideration of the claims is earnestly solicited. If, however, there is still an outstanding issue, the Examiner is invited to contact the undersigned for its prompt attention.

Respectfully submitted,
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